

## **REMARKS**

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the instant Amendment, Claims 1-5, 7-9, and 11-13 will be all of the claims presently pending.

Instantly, Claims 1-5, 7-9, and 11-13 have been amended and Claims 6 and 10 have been canceled without prejudice. Applicants' note this amendment is not made in acquiescence of the Office's position on the allowability of the claims but instead is made merely to expedite prosecution.

### **I. CLAIM OBJECTIONS:**

Claims 4, 8, 9, 10, and 13 are objected to for various reasons as set forth by the Examiner.

Applicants respectfully submit the claims as presently amended render the objections moot and, therefore, the withdrawal of the present objections to the claims is requested.

### **II. CLAIM REJECTIONS:**

#### **A. 35 USC 101**

Claim 12 stands rejected under Section 101 as being directed to non-statutory subject matter. Applicants respectfully submit, the claim as amended, recites a step and is directed toward a process and, thus, is directed to a statutory class of invention. Withdrawal of the rejection is requested.

## **B. 35 USC 112**

Claims 6, 7, and 12 stand rejected under section 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention.

With respect to Claims 6 and 7, the Office rejects the recitation of a range followed by a preferred narrower range.

Claim 6 has been cancelled; however, to the extent that the subject matter of Claim 6 has been incorporated into independent Claims 1 and 2, Applicants submit the recitation of “preferably” has been deleted, thereby obviating the rejection. Claim 7 has been amended in a similar manner to remove the “preferably” language.

As indicated above, Claim 12 has been amended to set forth a step to a process, thereby, addressing the present rejection.

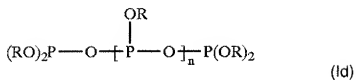
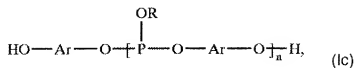
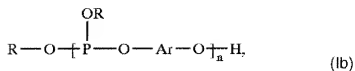
In light of the above, Applicants request the withdrawal of the present Section 112 rejections.

## **C. 35 USC 102**

Presently, Claims 1 and 6-13 are rejected under 35 USC 102(b) as anticipated by Magerstedt et al., USPN 5,726,227 (hereinafter “Magerstedt”). For the following reasons Applicants submit the presently amended claims are novel over the cited art.

Presently, the formulae Ib-IId, previously set forth in now canceled Claim 6, are incorporated into independent Claims 1 and 2, which now recite, *inter alia*):

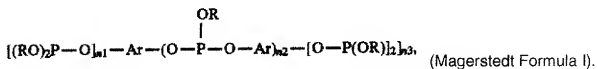
“[w]herein the polymeric phosphite conforms to at least one of the formulae (Ib), (Ic), or (Id),



where n is an integer equal to or greater than 2, R is, each independently, an alkyl, aralkyl, cycloalkyl, aryl, phenyl, or hetaryl, and at least one of the R groups comprises an oxetane group, and Ar is, each independently, aryl, said aryl may optionally be substituted by alkyl and/or hydroxyl....” (Claims 1 and 2)

None of the compounds represented by the formulae lb, lc, or ld are taught by Magerstedt.

As best understood, Magerstedt teaches various phosphorous acid esters. (Column 4, line 64). Such phosphorous acid esters conform structurally to Magerstedt Formula I



In contrast stands the claimed compounds of formulae lb through ld. Applicants would first like to draw the Examiner's attention to Applicants' claimed formula Id,

shown above. As can be seen, the repeating unit of Id is clearly different than that disclosed by Magerstedt. Namely, Id does not contain any aryl group as a part of its repeating unit. The compounds of Magerstedt clearly teach the inclusion of such an aryl group as part of the repeating unit of such compounds. The compound of presently claimed Id is simply not taught by Magerstedt.

Next, the remaining claimed formulae, Ib and Ic, of the present invention, are also not taught by Magerstedt. While the claimed compounds of formulae Ib and Ic do contain an aryl group as a part of their repeating units (-Ar-O-POR-O-), please note that at least one terminal end, in each case, is clearly different than the terminal ends as taught by Magerstedt. The compounds as taught by Magerstedt clearly terminate with a phosphite group P(OR)<sub>3</sub>. Thus compounds Ib and Ic are not taught by Magerstedt.

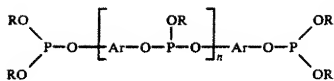
In light of the above, Applicants respectfully submit that the applied art does not anticipate the present invention because, at the very least, "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under construction." *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d 1540, 1554 (Fed. Cir. 1983); see also *In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

The outstanding anticipation rejections should now be withdrawn.

#### **D. 35 USC 103**

Presently, Claim 2 is rejected under 35 USC 103 as obvious over Magerstedt, while Claims 3-5 are rejected under 35 USC 103 as obvious over Magerstedt in view of Idel et al., USPN 5,231,124 (hereinafter "Idel"). For the following reasons Applicants submit the presently amended claims are non-obvious in view of the cited art.

As best understood, Idel teaches the following compounds of Ideal Formula I:



(Ideal Formula I).

For the same reasons as discussed above with respect to Magerstedt, Idel also clearly fails to teach or disclose the presently claimed compounds of the formulae Ib through Id.

As the Examiner is again assuredly aware, it is well-settled that to establish a *prima facie* case of obviousness it must be shown, among other things, that the prior art reference or combination of references teaches or suggests all of the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970).

Since Idel fails to overcome the deficiencies of Magerstedt it is respectfully submitted the presently amended claims are not obvious in light of either reference or the combination thereof. The obviousness rejections should now be withdrawn.

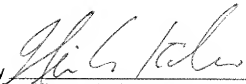
### III. CONCLUSION:

In summary, it is respectfully submitted that the instant application, including Claims 1-5, 7-10, and 11-13, is presently in condition for allowance. Notice to the effect is earnestly solicited.

If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

While no fees are believed to be necessary in connection with this submission, the USPTO is hereby authorized to charge any fees which may be required by this paper and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully,

By 

Nicanor A. Köhncke  
Attorney for Applicants  
Reg. No. 57,348

Lanxess Corporation  
Law & Intellectual Property Department  
111 RIDC Park West Drive  
Pittsburgh, Pennsylvania 15275-1112  
(412) 809-2234  
FACSIMILE PHONE NUMBER:  
(412) 809-1054

\\sr\\S:\\Law Shared\\SHARED\\IN\\PATENTS\\8305\\8305 Response & Amendment 04-03-08.doc